

REMARKS/ARGUMENTS

1. Remarks on the Amendments

Claims 1 and 3 have been amended to more specifically define Applicants' claimed invention.

New Claims 9-12 have been added.

Antecedent basis for the amendments and new claims can be found in the claims and the Specification as filed. Applicants respectfully submit no new matter has been introduced by the amendments.

2. Response to the First Rejection of Claims 1-8 Based Upon 35 U.S.C. §103(a)

Claims 1-8, and presumably new Claims 9-12, stand rejected under 35 USC §103(a) as being unpatentable over Fish (US Patent Application 2003/0220891). This rejection is respectfully traversed.

Applicant submits herein a new Declaration under 37CFR 1.131, which clearly shows that Applicant's claimed invention was conceived and reduced to practice prior to the effective date of December 22, 2000 of Fish's reference.

Applicant respectfully requests the Examiner's attention to the fact that Figs. 4-9 of the instant application are Figs. 1-6 of the parent application (Patent Application Serial No. 09/046,490), and that these drawings were the actual computer screen printouts of Applicant's experimental software version of the instant invention which was in experimental use prior to the effective date of Fish's reference. Therefore, Applicant is entitled an invention date prior to the effective date of Fish's reference.

Accordingly, Applicant maintains that Fish's reference is not qualified to be a reference against Applicant's claimed invention under 35 U.S.C. §103(a).

Applicant respectfully requests withdrawal of the rejection of Claims 1-12 based upon 35 U.S.C. §103(a).

3. Response to the Second Rejections of Claim 1-8 Based Upon 35 U.S.C. §103(a)

Claims 1-8, and presumably new Claims 9-12, stand rejected under 35 USC §103(a) as being unpatentable over Day et al (US Patent No. 4,763,356) in view of Shelton et al (5,325,478). This rejection is respectfully traversed.

Claims 1 and 9 are independent claims, and Claims 2-8 and 10-12 are dependent claims of Claims 1 and 9, respectively.

A determination under 25 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and prior art; and (4) the objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), see also *Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370 1376, 51 USPQ 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175, F.3d 994, 1000, 50 USPQ 2d 1614, 1617. The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). The mere fact

that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The Examiner has the burden of establishing a prima facie case of obviousness. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a prima facie case has been established. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993). Only if the burden of the establishing prima facie case is met does the burden of coming forward with rebuttal argument or evidence shift to the application. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995), see also *Ex parte Obukowicz*, 27 USPQ 2d 1063, 1065 (B.P.A.I. 1992).

Applicant submits that nothing in the art of record teaches or suggests the subject matter positively recited in Claims 1 and 9. More specifically, Applicant's claimed method defined by Claims 1 and 9 requires configuring a data form, intended for real time use during a physical examination or technical inspection, into a geometry sufficient to display the entirety thereof upon a single screen of a computer monitor.

Day et al fail to teach Applicant's claimed method which displays the entire data form upon a single screen of the monitor. Instead, Day et al teach the opposite. The pertinent sections of Day et al's teaching are recited below (Column 5, line 67 to Column 6, line 29):

It is assumed at this point in the discussion that page 1 of form 30 has been filled in and the system has highlighted the SP EQUIP (special equipment) button 102. When the user points to button 102, the system erases page 1 of form 30 and displays page 2 of form 30, as shown in FIG. 10.

.....Upon filling in field 110, the user touches the RTN (return) button 111. When the user does so, the system erases page 2 and redisplay page 1 of form 30. (Emphasis added)

Therefore, Day et al teach away from Applicant's claimed invention. Day et al's teaching recited above is exactly what Applicant eliminates, because it is difficult and impractical for real time use during a physical examination, or technical inspection in an inconvenient field environment.

Day et al's deficiencies are not overcome by Shelton et al.

Shelton et al teach a method which consolidates information from various object instances onto a single form. However, Shelton et al fail to teach Applicant's claimed displaying the entire data form upon a single screen. In fact, a suggestion or teaching of Applicant's claimed method step of configuring a data form and displaying the entire form upon a single screen is absent in Shelton et al's reference.

Furthermore, as shown in Figs. 5 and 6 of Shelton et al's reference, the user needs to scroll down on the screen in order to see all information in the display area 105 of form 100 of Fig. 2. For example, data cell 465 discussed in the specification of the reference (Column 5, lines 53-58) is not shown on the screen, and can not be viewed without scrolling down. This is opposite of the inventive features of Applicant's claimed method.

Based on the prior art's teaching, one skilled in the art would not be motivated to combine Day et al and Shelton et al's references to obtain Applicant's claimed invention, as suggested by the Examiner. Even if one combines, one would obtain a single form with information consolidated from various instances, as taught by Shelton et al, yet displayed on more than one single screen, as taught by Day et al (i.e., form 30).

Therefore, Applicant maintains that Applicant's claimed invention defined by independent Claims and 9 is not obvious in view of the prior art of the record.

With regard to Claims 2-8 and 10-12, as described above, these claims are dependent upon independent Claims 1 and 9. Under the principles of 35 U.S.C. §112, 4th paragraph, all of the limitations of each independent claim are recited in its respective dependent claims. As described above, independent Claim 1 is unobvious in view of the prior art of record, as such Claims 2-8 and 10-12 submitted as being allowable over the art of record.

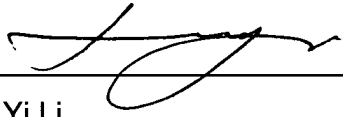
Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 1-12 based upon 35 U.S.C. §103(a).

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It is respectfully submitted that Claims 1-12, the pending claims, are now in condition for allowance and such action is respectfully requested.

Applicants' Agent respectfully requests direct telephone communication from the Examiner with a view toward any further action deemed necessary to place the application in final condition for allowance.

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